

Docket No.: MML-003
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Jerome S. Golden

Application No.: 09/541,197

Confirmation No.: 4910

Filed: April 3, 2000

Art Unit: 3691

For: **SYSTEM AND METHOD FOR PROVIDING
SECURE RETIREMENT BENEFITS VIA A
CONVERSION PROCESS**

Examiner: S. E. Chencinski

RESPONSE TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This communication is responsive to the Notification of Non-Compliant Appeal Brief mailed September 11, 2008. Appellant filed an original Appeal Brief on May 20, 2008. On May 29, 2008, the Office mailed a Notification of Non-Compliant Appeal Brief which asserted that the summary of claimed subject matter in the Brief failed to comply with 37 C.F.R. 41.37(c)(1)(v). Appellant filed a paper providing a compliant summary of the claimed subject matter on June 25, 2008. On August 25, 2008, the Examiner mailed a second Notification of Non-Compliant Appeal Brief which asserts: "The BPAI requires that an amended Appeal Brief be submitted in its entirety." Appellants noted in a response filed August 27, 2008, that there is no authority to support the Examiner's requirement that an amended Appeal Brief must be submitted in its entirety. Nonetheless, Appellant submitted an Amended Appeal Brief submitted in its entirety including the summary of the claimed subject matter from the Appellant's June 25, 2008, filing.

The Examiner now asserts that Appellant's Brief remains non-compliant because the brief requests review of three sets of dependent claims argued separately. The Examiner erroneously asserts that dependent claims argued separately must be accompanied by summaries

of the claimed subject matter. However, there is no authority for imposing such a requirement.

Title 37 C.F.R. § 41.37(c)(1)(v) states that the Appeal Brief shall contain:

A concise explanation of the subject matter defined in *each of the independent claims* involved in the appeal . . . For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of the section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth.

(emphasis added) The first sentence of 37 C.F.R. § 41.37(c)(1)(v) makes clear that claim summaries of the claimed subject matter is only required only for *each of the independent claims* involved in the appeal. The second sentence provides that dependent claims argued separately need only have means plus function or step plus function limitations identified and set forth with the corresponding structure, material or acts from the specification. However, there are no means plus function or step plus function limitations under 35 U.S.C. § 112, sixth paragraph, in the dependent claims argued separately. Accordingly, Appellant respectfully submits that there is no authority for the Examiner's requirement that claim summaries are required for the dependent claims argued separately in this appeal. Notwithstanding, Appellant submits concurrently herewith a Second Amended Appeal Brief including summaries of the dependant claims argued separately. In view of the Examiner's previous requirement, an entire Brief is submitted herewith that replaces the prior Amended Appeal Brief. Appellant requests that this Second Amended Appeal Brief be considered by the Examiner. Any fees that may be due with this response may be charged to the undersigned's deposit account 50-4494.

Dated: October 9, 2008

Respectfully submitted,

By: /Carl L. Benson/

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